TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission	7

Application No.	09/802,707
Filing Date	March 8, 2001
First Named Inventor	Mike G. Roemmler
Art Unit	1754
Examiner Name	Lish, Peter J.
Attorney Docket Number	71300P010

ENCLOSURES ***(check all that apply)***

- ☒ Fee Transmittal Form
  - ☐ Fee Attached
- ☐ Amendment / Response
  - ☐ After Final
  - ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
  - ☐ PTO/SB/08
- ☐ Certified Copy of Priority Document(s)
- ☐ Response to Missing Parts/ Incomplete Application
  - ☐ Basic Filing Fee
  - ☐ Declaration/POA
  - ☐ Response to Missing Parts under 37 CFR 1.52 or 1.53
- ☐ Drawing(s)
- ☐ Licensing-related Papers
- ☐ Petition
- ☐ Petition to Convert a Provisional Application
- ☐ Power of Attorney, Revocation Change of Correspondence Address
- ☐ Terminal Disclaimer
- ☐ Request for Refund
- ☐ CD, Number of CD(s)
- ☐ After Allowance Communication to Group
- ☒ Appeal Communication to Board of Appeals and Interferences
- ☐ Appeal Communication to Group **(Appeal Notice, Brief, Reply Brief)**
- ☐ Proprietary Information
- ☐ Status Letter
- ☒ Other Enclosure(s) *(please identify below):*

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Remarks

Appeal Brief 2005-2368

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm *or* Individual name	William Thomas Babbitt, Reg. No. 39,591 BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Signature	William T Babbitt
Date	November 22, 2005

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Typed or printed name	Marilyn Bass		
Signature	Marilyn Bass	Date	November 22, 2005

FEE TRANSMITTAL for FY 2005

Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27.

TOTAL AMOUNT OF PAYMENT ($)

Complete if Known	
Application Number	09/802,707
Filing Date	March 8, 2001
First Named Inventor	Mike G. Roemmler
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Art Unit	1754
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METHOD OF PAYMENT *(check all that apply)*

☐ Check ☐ Credit card ☐ Money Order ☒ None ☐ Other (please identify): _____

☒ Deposit Account Deposit Account Number: 02-2666 Deposit Account Name: Blakely, Sokoloff, Taylor & Zafman LLP

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

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FEE CALCULATION

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet.	
2053	130	2053	130	Non-English specification	
1251	120	2251	60	Extension for reply within first month	
1252	450	2252	225	Extension for reply within second month	
1253	1,020	2253	510	Extension for reply within third month	
1254	1,590	2254	795	Extension for reply within fourth month	
1255	2,160	2255	1,080	Extension for reply within fifth month	
1401	500	2401	250	Notice of Appeal	
1402	500	2402	250	Filing a brief in support of an appeal	
1403	1,000	2403	500	Request for oral hearing	
1451	1,510	2451	1,510	Petition to institute a public use proceeding	
1460	130	2460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
1809	790	1809	395	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	790	2810	395	For each additional invention to be examined (37 CFR § 1.129(b))	

Other fee (specify) _____

SUBTOTAL (2) ($)

SUBMITTED BY *Complete (if applicable)*

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Signature	William T Babbitt			Date	11/22/05

Based on PTO/SB/17 (12-04) as modified by Blakely, Sokoloff, Taylor & Zafman (wlr) 12/15/2004.
SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Attorney's Docket No. 071300.P010

BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	
Mike G. Roemmler	**Appeal No. 2005-2368**
Application No. 09/802,707	Examiner: List, Peter J.
Filed: March 8, 2001	Art Unit: 1754
For: METHOD OF MAKING EXPANDED GRAPHITE WITH HIGH PURITY AND RELATED PRODUCTS	

REQUEST FOR RECONSIDERATION UNDER 37 CFR §41.52

Board of Patent Appeals and Interferences
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

In connection with the Decision on Appeal mailed September 23, 2005, Appellant respectfully requests a rehearing.

In the Decision on Appeal, the Patent Office found claims of Group I (claims 1-11, 13-21 and 23-27) obvious under 35 U.S.C. §103(a) over Greinke et al. (Greinke). According to the Patent Office, Greinke disclosed a process that is the same as the claimed invention except for the purification of the expanded graphite at a temperature of 1750°C. The Patent Office also noted that Greinke disclosed a purification of expanded graphite occurs at a temperature above 600°C and exemplifies the temperature of 1700°C. According to the Patent Office, a prima facie case of obviousness exists when the claimed range and the prior range do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. The Patent Office found the claims obvious and noted that Appellant had not argued that the claim temperature provides unexpected results.

As the Patent Office realizes, unexpected results is not the only basis for rendering claims not obvious over the cited references. In the particular case, Appellant argued that Greinke did not teach a temperature of at least 1750°C for the heat treatment and further there was no motivation for a person of skill in the art, based on the teachings of Greinke or the prior art of record to use a temperature of at least 1750°C for the heat treatment because Greinke, in essence, taught away from that temperature. It appears that the Patent Office overlooked or misapprehended this analysis as it was not addressed in the Decision on Appeal. Accordingly, Appellant requests that the Patent Office re-hear the pending appeal on that basis.

The argument that Appellant believes was misapprehended or overlooked is set forth in the Appeal Brief (see, pages 7-8) and is summarized below.

Greinke teaches that:

> The purpose of the second heat treatment is to remove from the graphite surface, hydrophilic acid groups introduced either by the intercalant or by the acidic stabilization reagent, without removal of the desired hydrophobic stabilization functional groups, such as those which contain phosphorous or chlorine. Therefore, the second heat treatment should have a temperature limitation which is below the fracturing temperature of the stabilizing functional group but above the temperature required to remove the acid functional groups of above about 600°C. Greinke Col. 5, lines 38-47 (emphasis added).

The quoted passage suggests that there is an upper limit to the heat treatment of Greinke since there is an undesirable fracturing temperature. This upper limit must be about 1000°C since Greinke states, "the second heat treatment should go between 600° and about 1000°C for a controlled time period with a longer hold time required for the 600°C. temperature and a shorter hold time required for the higher 1000°C. temperature." Greinke, Col. 5, lines 50-54. This suggests there is an upper limit and that upper limit is 1000°C since Greinke refers to "the higher 1000°C temperature," the highest temperature in the range, in the singular. This also suggests that the fracturing temperature is 1000°C and any temperature above 1000°C would be unacceptable since it will cause the stabilizing functional group to fracture. Thus, one skilled in the art reading Greinke would not have had the proper motivation to use temperatures of at least 1750°C for fear of causing the stabilizing functional group to fracture.

Greinke shows examples that have a maximum temperature of 1700°C but does not suggest these examples are useful especially in light of the above argument that 1000°C is the highest allowable temperature, the fracture temperature, taught by Greinke. In addition, Example 10 of Greinke, which uses 1200°C, is equally non-suggestive since Greinke teaches that the product, which was supposed to be blister-free, blistered after only 90 days. See Greinke, Col. 7, lines 33-36. Therefore, there would be no motivation for one skilled in the art to look at temperatures above 1000°C when reading Greinke since each example resulted in an unacceptable product. Therefore, there is no teaching or suggestion in Greinke of a temperature of at 1750°C as recited in the claims of Group I. In fact, Greinke teaches away from extending a temperature from 1700°C to 1750°C. If anything, Greinke teaches using temperatures below 1000°C.

Additionally, to raise the temperature from the 600°C to 1000°C range to at least 1750°C requires greater power and thus, is more expensive to attain. Therefore, one skilled in the art would not be inclined to use a more costly, more difficult approach to accomplish the same task, especially in light of the fact that each of the examples at higher temperatures gave unacceptable results. Again, there is no suggestion or motivation in Greinke to use temperatures of at least 1750°C. Accordingly, it is requested that the anticipation/obviousness rejection of the independent claims of Group I be overturned.

As noted in its Appeal Brief and the Decision on Appeal, Greinke forms the basis for the rejection of the claims in each of Groups I-III. In view of the above arguments, Applicant requests rehearing of each of claims 1-27 and Groups I-111 as the arguments presented above with Greinke apply equally well to those claims and groups.

CONCLUSION

Accordingly, it is submitted that the rejections of elements 1-27 based on 35 U.S.C. §103(a) be overturned.

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance and such action is earnestly solicited at the earliest possible date.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: November 22, 2005

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Marilyn Bass November 22, 2005